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10/543,146

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Jukka Jarvinen

3505-1020

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466 7590 02/08/2007  
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EXAMINER

ROBINSON, ELIZABETH A

ART UNIT

PAPER NUMBER

1773

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/543,146

Applicant(s)

JARVINEN, JUKKA

Examiner

Elizabeth Robinson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7-25-2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: In the specification (Page3, line 9) and in claim 5, the rosin alcohol is referred to a hydroabiethyl alcohol. These alcohols are hydroabietyl alcohols. This appears to be a clerical error. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 through 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Neither the claims nor the specification indicates the basis of the percentages for the polyisobutylene. It is noted that the inventor considers the percentage of polyisobutylene to be an important feature of the invention. There is no indication if these percentages are weight percent, volume percent, mol percent or some other measure. This renders claim 1 indefinite and also all other claims dependent on claim 1. Also, there is also no indication of a molecular weight range to define what is meant by high-molecular-weight polyisobutylene. In claim 1, it is unclear what the term "or various modifications of" means with respect to rosin alcohol. Does this mean various types of rosin alcohol, or is some modification being made to the rosin alcohol.

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 3, 4, 6, and 9 recite a broad recitation, followed a narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, and 5 through 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al. (US 2,124,235), in view of Hopkins et al. (US 3,632,540).

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Regarding claims 1 and 5, Werner (Page 2, line 70) teaches a ski wax that is 50% by weight polymerized isobutylene and 30% by weight montan-wax and 20% by weight tallow. Since a basis for the percentage of polyisobutylene in the instant application was not given, the examiner interprets this percentage to meet the required polyisobutylene percentage. The polymer has a very high molecular weight of at least about 100 and ranging up to 10,000 or higher (Page 1, Column 1, lines 17 through 26). Werner does not include rosin alcohol in the composition. Hopkins (Column 1, lines 32 through 43) teaches a polymer, wax, resin composition that is used as a coating and is therefore analogous to the art of Werner. The resins are taught by Hopkins in Column 10, lines 20 through 60 and in Table II. These resins are used to enhance the blendability and viscosity of the wax, polymer mixture (Column 10, lines 24). The appropriate resins used are listed in Table II and include wood rosin and hydroabietyl alcohol. It would be obvious to one of ordinary skill in the art to add the resin of Hopkins, to the ski wax of Werner to enhance the blending of the mixture and as a viscosity modifier to obtain the desired ski wax performance.

Regarding claim 6, the resin of Hopkins is added to the composition at a weight percentage of 2 to 50% (Column 1, lines 32 through 37). This overlaps the range of the instant claims.

Regarding claims 7 and 8, the claimed paraffin and beeswax are functionally equivalent to montan-wax for coating purposes. This is evidenced by Holmberg (US 1,754,827) (Page 1, line 54 through 58). Therefore, it would have been obvious to one of ordinary skill in the art to modify the invention of Werner, by substituting beeswax or

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paraffin for montan-wax, because the three waxes are taught by Holmberg to be equivalent for coating purposes.

Regarding claim 9, the composition of Werner is 30% by weight wax (Page 2, Example 7). It is assumed that this weight percentage is encompassed by the instant claim.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al. (US 2,124,235), in view of Hopkins et al. (US 3,632,540), and further in view of Creutz et al. (DD 231219). Creutz (see abstract) teaches a ski wax composition that includes polyisobutylene, wax and resin, particularly a natural tree resin. Werner does not teach the specific polyisobutylene percentages recited in the applicant's claims. Creutz teaches varying the proportions of wax, rein, plasticizer, and viscosity stabilizer to suit different snow conditions. It would be obvious to one of ordinary skill in the art to slightly adjust the percentage of polyisobutylene, in the wax of Werner, in order to obtain the desired grip properties of the ski wax at different temperatures.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al.), in view of Hopkins et al. as applied to claim 1 above, and further in view of Lawrence et al. (US 4,343,863). The ski wax of Werner modified as applied to Claim 1, does not include a toughening agent. However, Lawrence teaches a ski wax composition that contains polyethylene to make the wax film less brittle (Column 2, lines 48 through 51). This compound was added to the composition in an amount of 2 to 20 % by weight (Column 2, lines 53 through 59). This is assumed to overlap the range of the instant claim. The polyethylene was specified to have a melting point of 215 to

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230°F (Column 2, lines 64 and 65). Low density (LD) polyethylene has a melting point in this range. It would be obvious to one of ordinary skill in the art to add LD polyethylene to the ski wax composition to make the wax film less brittle.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al.), in view of Hopkins et al. as applied to claim 1 above, and further in view of Aasen (WO 80/013558). Aasen (Page 1, lines 5 through 7) teaches a method for transferring bands of ski wax onto skis from a transfer substrate, referred to as flexible protective bands. The wax can be liquid when applied to the transfer substrate (Page 3, lines 37 and 38). Aasen (see abstract) teaches that the ski wax attached to the flexible band is prefabricated to the final shape and size required for the use on the running surfaces of the skis. The abstract also teaches that the wax-band is very thin. Aasen (Page 3, lines 24 through 35) teaches that the wax is placed onto the ski using only pressure and that the protective band is then removed. Aasen does not teach a ski wax formula for use with this method. Aasen does teach that a cross-country skiing wax should have good sliding qualities, but also have good gripping effect (Page 1, lines 17 through 22). It would be obvious to one of ordinary skill in the art to choose a ski wax appropriate for the type of skiing desired. The ski wax of Werner modified as applied to Claim 1, would have good grip capability due to the adhesive nature of polyisobutylene (Page 1, Column 2, lines 41 through 47).

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Robinson whose telephone number is 571-272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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*EAL*

  
**CAROL CHANEY**  
**SUPERVISORY PATENT EXAMINER**